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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,671	04/24/2000	Michael Stephen Austin	792-21 RCE	7622

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EXAMINER

REIMERS, ANNETTE R

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/556,671	Applicant(s) AUSTIN, MICHAEL STEPHEN	
	Examiner Annette R. Reimers	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-15, 17-24, 27-31, 33-37 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15, 17-24, 27-31, 33-37 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 13, 15, 17-24, 27, 29, 31, 33-37 and 42-45 rejected under 35 U.S.C. 102(b) as being anticipated by Rhodes (US Patent Number 5,122,154)

Rhodes disclose various embodiments of an endoluminal prosthesis, e.g. 30, comprising a proximal end, a distal end and a thin-walled hollow tubular body, e.g. 28, comprising a stent scaffold, having a V-shaped or quadrilateral-shaped cells, the stent scaffold consisting essentially of helically wound undulating wires having alternating peaks and valleys to define turns thereat, wherein the peaks of adjacent undulating wires are interconnected (see column 7, lines 46-50), the hollow tubular body comprising at least one segment of curvature, the segment of curvature comprising an inside of the curvature and an outside of the curvature, wherein the wires and their turns are distributed substantially equally and uniformly displaced along the length of the prosthesis, including being distributed substantially equally and uniformly displaced along the length of the segment of curvature to provide a constant pitch of the wires therealong (see figures 1 and 7). In addition, the wires can have an increased pitch at the outside segment and have a reduced pitch at the inside segment when disposed on

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a straight mandrel and wherein the increased pitch at the outside segment is relative to the reduced pitch at the inside segment (see figures 1-10).

The segment of curvature is curved in at least one plane with respect to the central axis of the body, the segment of curvature is curved in at least two planes with respect to the central axis of the body, the hollow tubular body has at least two segments of curvature wherein the segments of curvature are located in successive progression along the body of the prosthesis and the segments are curved within the same plane of curvature, the hollow tubular body has at least two segments of curvature wherein the segments of curvature are located in successive progression along the body of the prosthesis and the segments are curved within different planes of curvature, the hollow tubular body has at least two segments of curvature wherein the segments of curvature overlap at least a portion of one another and the segments of curvature are curved within different planes of curvature, comprising segments of curvature which overlap and segments of curvature which do not overlap (see figures 1-10).

The prosthesis comprises at least one segment of curvature to approximate an anatomical shape, wherein the prosthesis approximates the anatomical shape of the anatomical site intended for placement of the prosthesis (see figures 1-10). Rhodes disclose the use of the wires comprising a polymer (see column 6, lines 34-36). The prosthesis comprises at least one taper along the length of the body, the prosthesis comprises at least one aperture on the body between the proximal end and the distal end, the prosthesis comprises at least one non-circular cross-section along the length of the body and the prosthesis further comprises at least one branch of the prosthesis that

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extends away from the body of the prosthesis (see figures 1-10). At least a portion of the prosthesis is covered with a graft covering (see column 7, lines 1-3).

With regard to the statement of intended use and other functional statements, e.g. "the wires can have an increased pitch at the outside segment and have a reduced pitch at the inside segment when disposed on a straight mandrel", they do not impose any structural limitations on the claims distinguishable over Rhodes, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 12, 14, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes (US Patent Number 5,122,154) in view of MacGregor (US Patent Number 4,994,071), previously cited by applicant.

Rhodes discloses the claimed invention except for the specific materials of the self-expanding stent, e.g. super elastic alloys and nitinol. MacGregor teaches that many different materials may be selected to be used in a stent including super elastic alloys and nitinol and teaches the use of these materials in order to vary springiness, malleability, bioabsorbability, or biodegradability and response to temperature (see column 5, lines 38-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Maass et al. with a different material, in view of MacGregor, in order to vary springiness, malleability, bioabsorbability, or biodegradability and response to temperature.

Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes (US Patent Number 5,122,154) in view of Maass et al. (US Patent Number 4,553,545), previously cited by examiner.

Rhodes discloses the claimed invention except for the wires comprising a shape memory alloy. Maass et al. teach a stent device and teach that the use of shape memory alloys is well known in the art (see column 1, lines 45-53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the wires comprise a shape memory alloy, in view of Maass et al., since the use of shape memory alloys is well known in the art.

Response to Arguments

Applicant's arguments with respect to claims 1-9, 11-15, 17-24, 27-31, 33-37 and 42-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

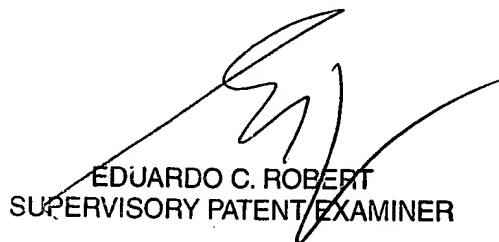
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER